

## **REMARKS**

### **Summary**

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46, and 48-71 are pending. Claims 18 and 33 are amended. No new matter has been introduced.

### **Rejections Under 35 USC 103**

#### **Pennell, Winbladh, and Waskiewicz**

Claims 1-6, 15-16, 20, 28-29, 41, 45-46, 56-57, 59-60, 62, 64-67, and 71 are rejected over US Patent No. 6,874,023 to Pennell et al. (Pennell) in view of US Patent No. 6,205,330 to Winbladh (Winbladh) in further view of US Patent No. 5,822,526 to Waskiewicz (Waskiewicz). Applicant respectfully traverses the rejection in light of the remarks below.

Claim 1 provides a method comprising a user computer providing a first email address received from an email service provider for use to register a user of the user computer with a first web site; the user computer providing a second email address received from the email service provider, separate and distinct from the first email address, for use to register said user with a second web site; wherein the first and second email addresses were simultaneously provided to the user computer by the email service provider in advance of providing the first and second email addresses to the first and second web sites by the user computer.

Thus, according to claim 1, a user computer communicates with an email service provider to receive first and second separate and distinct email addresses provided simultaneously and in advance of the user computer in turn providing the first and second email addresses to the first and second web sites to register a user.

Pennell is cited for teaching the provision of email addresses for use to register a user with a first and second website. Notably, the system in Pennell self-generates individual email addresses as needed, and thus does not receive email addresses from an email service provider as recited in claim 1. In addition, the

Office Action admits that Pennell fails to teach the simultaneous provision of the first and second email addresses to the user computer.

The Office Action states that the simultaneous provision of email addresses is not supported by the specification, despite the fact that no rejection has been asserted in this regard. In fact, there is support for such a teaching, found in the Specification, for example, at page 10, lines 17-21, as well as elsewhere in the Specification.

Winbladh and Waskiewicz are cited for teaching the simultaneous provision of first and second email addresses to the user computer. However, neither Winbladh nor Waskiewicz teach the simultaneous provision of first and second email addresses that are “separate and distinct” as recited in claim 1.

Winbladh teaches the provision of a primary email address and at least one alias address. An alias address is associated with and dependent on the primary address, and thus the addresses are not “separate and distinct.” An alias address is translated into the primary address upon use or an access attempt. Thus, there is a clear required connection between the alias address and the primary address, as the alias is simply a stand-in for the primary address. Such a coupled relationship lends itself to provision jointly, whereas the simultaneous provision of separate and distinct email addresses, as recited in claim 1, is not taught or suggested.

The Office Action asserts that it is unclear the extent of distinction or separateness required by the terms “separate and distinct”. First, Applicant uses the term “separate” and the term “distinct” indicating meaning for both. The term “separate” as used to describe two email addresses may indicate that the two addresses are not the same address, that they are independent. The term “distinct” highlights the distinguishing characteristics of the two addresses. According to Merriam-Webster’s 3<sup>rd</sup> New International Dictionary, the term “separate” means “existing by itself, autonomous, independent,” while the term “distinct” means “characterized by qualities individualizing or distinguishing as apart from, unlike, or not identical with another or others”. Thus, the terminology “separate and distinct” used in the claims and throughout the specification is intended to highlight the independent nature of the two email addresses and having qualities distinguishing

one from the other. Clearly the provision of addresses that are dependent upon each other, such as a primary address and a derivative alias address which refers back and routes to the primary address, cannot provide a teaching of the provision of addresses that are independent of each other.

Waskiewicz teaches the provision of one or more proxy addresses that are associated with a single account name. Thus, a proxy address is directly related to a master account and the proxy address is a “stand-in” or substitute address for the master. This teaching is essentially the same as that of Winbladh. Clearly, the proxy addresses are interrelated and are dependent on the master, and thus are not “separate and distinct.” Such a coupled relationship lends itself to provision jointly, whereas the simultaneous provision of separate and distinct email addresses, as recited in claim 1, is not taught or suggested.

The “separate and distinct” email addresses of claim 1 are not simply proxy or alias addresses, which would not provide the separateness or distinctiveness desired. Proxy and alias addresses are translated into the primary address upon receipt of a message, thus all messages received using any of such addresses are routed to the primary address. Clearly, the connected and dependent relationship of such addresses is present.

The method of claim 1 thus provides for multiple separate and distinct email addresses to be provided simultaneously for use, respectively, to register with different websites. Thus, the user computer has access to the provided email addresses in advance of registering with the websites, thus saving time and resources when the addresses are needed. These features are not provided by the cited references.

In addition to the technical deficiencies of the references discussed above, there is further no motivation to combine the references. Pennell provides a system in which email addresses are generated one at a time, when needed. Pennell provides no teaching or suggestion to modify such a feature to provide multiple email addresses simultaneously. In addition, since the email addresses in Pennell are provided when needed, without any further teaching in this regard, there would

be no need to supply multiple addresses at the same time and there is no teaching provided to the contrary.

With respect to Winbladh and Waskiewicz, both systems are intended to specifically interrelate the provided email addresses, and thus there is certainly no teaching or suggestion to modify the arrangements to allow for the provision of “separate and distinct” email addresses (as recited in claim 1).

Thus, there is clearly no motivation to combine the cited references, and no motivation provided by the problem to be solved. Instead the attempt to combine these references amounts to improper hindsight reconstruction using Applicant’s claims as a roadmap.

Therefore, Pennell, Winbladh, and Waskiewicz fail to teach at least one element of claim 1, and there is no motivation to combine, and thus claim 1 is patentable over the cited references.

Claims 28, 41, 45, 56, 59, 62, and 67 contain language similar to that of claim 1, and are therefore patentable over the cited references for at least the reasons discussed above with respect to claim 1.

In addition, independent claim 41 adds the concepts of obtaining email addresses in real time, and earmarking the email addresses for use with a first and second communication partner. The cited references fail to teach or suggest such features, and the Office Action is silent in this regard. As discussed above, Pennell describes the creation of email addresses when needed, but does not discuss obtaining separate and distinct email addresses in real time and earmarking the addresses for use with certain communication partners, as recited in claim 41.

Claim 2-6, 15-16, 20, 29, 46, 57, 60, 64-66, and 71 are dependent on claims 1, 28, 41, 45, 56, 59, 62, and 67 respectively incorporating their limitations and are thus patentable over the cited references for at least the reasons discussed above.

#### Pennell, Winbladh, Waskiewicz, and Hall

Claims 13-14, 24, 26-27, 31-32, 42-44, 48-49, 58, and 61 are rejected over Pennell in view of Winbladh in further view of Waskiewicz in further view of US

Patent No. 5,930,479 to Hall. Applicant respectfully traverses the rejection in light of the remarks below.

Claims 13-14, 31-32, 42-44, 48-49, 58, and 61 are dependent directly or indirectly on claims 1, 28, 41, 45, 56, and 59 and thus are patentable over Pennell, Winbladh, and Waskiewicz for at least the reasons discussed above. Hall fails to overcome the deficiencies of Pennell, Winbladh, and Waskiewicz discussed above and thus claims 13-14, 31-32, 42-44, 48-49, 58, and 61 are patentable over the cited references.

Claim 24 recites a method comprising an electronic device requesting and receiving for a user, a first email address from an email service provider at a first point in time subsequent to the user subscribing for email service with the email service provider; the electronic device employing the received first email address to facilitate communication between the user and a first communication partner or group of communication partners; the electronic device, prior to the first communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the first email address to facilitate communication with the first communication partner or group of communication partners; the electronic device requesting and receiving for the user, a second email address, separate and distinct from said first email address, from the email service provider at a second point in time subsequent to the user subscribing for email service with the email service provider, the second point in time being a later point in time than the first point in time; the electronic device employing the received second email address to facilitate communication between the user and a second communication partner or group of communication partners; and the electronic device, prior to the second communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the second email address to facilitate communication with the second communication partner or group of communication partners.

Claim 24 recites a series of features that include (1) an electronic device requesting and receiving an email address for a user from an email service provider

subsequent to the user subscribing for service with the email service provider; and (2) the electronic device using the address for communication and notifying the email service provider of such use prior to receiving a communication from the partner or group or partner.

Pennell is cited for teaching an electronic device requesting and receiving for a user from an email service provider a series of email addresses. Notably, the system in Pennell self-generates individual email addresses as needed, and thus does not receive email addresses from an email service provider as recited in claim 24. Winbladh and Waskiewicz discuss the creation of alias and proxy addresses, which are not separate and distinct addresses (as discussed in detail above) and which have nothing to do with the notification operations discussed above. The Office Action agrees, and thus cites Hall.

Hall is cited for teaching the notification operations of claim 24; however, Hall does not teach the electronic device providing notice back to the email service provider when the email address is used. Hall provides for the creation and use of various channels for communication. The relevant cited portion of Hall (Column 20, lines 45-53) provides that specific channels may be used for specific types of communications. For example, a public channel may be used for communication with lower priority communication partners. However, the receipt of the email address, use of the address, and the resulting notification of such use in advance of a communication partner using the provided address is not taught or suggested by Hall. The feature of claim 24 indicates that the notification of usage sent from the electronic device to the email service provider occurs before the communication partner initiates communication with the user. Thus, the email service provider is forewarned of the potential communication from the communication partner. This feature is not taught by Hall. Rather, Hall provides a mechanism to designate or categorize particular channels for particular types of communications. Such a disclosure would be analogous to a user identifying one email address for personal use and a second email address for business use. However, Hall does not provide notification of use of a particular address when the address is employed (prior to use by the communication partner(s)), as recited in claim 24. In Hall, there is no

indication (notification) provided that indicates the email address has been employed, as defined in claim 24.

Furthermore, the Office Action fails to recite a proper motivation to combine. The provided motivation is simply a conclusory statement of the effect of the combination, not of the motivation to make such a combination. The recitation in the Office Action is clearly a case of improper hindsight reconstruction using Applicant's claims as a roadmap.

The Office Action states that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." This statement does not complete the picture. The improper nature of the hindsight reconstruction is that Applicant's claims have been simply used as a roadmap to find the recited elements in the art as opposed to reconstructing a singular teaching from a collection of teachings for which there is present a motivation to combine. Thus, it is not simply a matter of the presence of the elements in the art, and thus arising to the "knowledge which was within the level of ordinary skill in the art," but rather an explanation of how one of ordinary skill in the art would be motivated to make the specific combination of references proposed in the Office Action.

Thus, the cited motivation in the Office Action, namely that it would have been obvious to combine the teachings "to provide means for determining which channelized email address is associated with which correspondent – this allows for reliable categorization and filtering based on the different channel identifiers, providing a user with the means to specify a particular channel when corresponding with a specific website or user," does little more than restate a portion of the teachings of Hall. The Office Action provides no reason why one would be motivated to combine the teachings, but rather attempts to identify the result if one made such a combination. Such a presentation is insufficient to establish a motivation to combine the references.

Therefore, Pennell, Winbladh, Waskiewicz, and Hall fail to teach at least one element of claim 24, there is no motivation to combine, and thus claim 24 is patentable over the cited references.

Claims 26 and 27 are dependent on claim 24 incorporating its limitations and thus are patentable over the cited references for at least the reasons discussed above.

Pennell, Winbladh, Waskiewicz, and Gabber

Claims 12, 17-19, 33-38, 50-55, 63, and 68-70 are rejected over Pennell in view of Winbladh in further view of Waskiewicz in further view of US Patent No. 6,591,291 to Gabber. Applicant respectfully traverses the rejection in light of the remarks below.

Claims 12, 17-19, 63, and 68-70 are dependent directly or indirectly on claims 1, 62, and 67 and thus are patentable over Pennell, Winbladh, and Waskiewicz for at least the reasons discussed above. Gabber fails to overcome the deficiencies of Pennell, Winbladh, and Waskiewicz discussed above and thus claims 12, 17-19, 63, and 68-70 are patentable over the cited references.

Further, with respect to claim 12, claim 12 provides for the user computer notifying the email service provider of the usage of the first and second email addresses, including addresses of the first and the second web site. In response thereto, the Office Action cites Gabber (Column 3, lines 35-41 and Column 8, lines 27-50). The cited sections of Gabber teach the mechanism for handling incoming messages using an alias address. The message may be blocked if matched to a "reject" list or translated into the source address if the receipt of the message is allowed. However, these teachings do not discuss the user computer notifying the email service provider of the use of the first and second email addresses, including the websites with which the email addresses have been employed. The method recited in claim 12 provides for communication of both usage of the email addresses and the particular websites with which the addresses have been utilized so that the email service provider may properly monitor the usage and/or properly handle the incoming messages. The described notification operation is however not provided by Gabber. Thus, claim 12 is patentable over the cited references for this additional reason. Claims 13 and 14 are dependent on claim 12 and thus are patentable over



the cited references for at least the additional reasons described above with respect to claim 12.

Claim 33 provides a method comprising an email service provider receiving emails addressed to a first and a second email address of a user, the first and second email addresses being separate and distinct from each other and having been provided by the email service provider to an electronic device of the user for the electronic device to facilitate respective communication between the user and a first and a second intended communication partner; and the email service provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses of the user.

Thus, claim 33 provides for the email service provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses.

Claim 33 is patentable over Pennell, Winbladh, and Waskiewicz for the reasons discussed above. Furthermore, with respect to claim 33, the Office Action admits that Pennell, Winbladh, and Waskiewicz fail to teach organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses. Thus, the Office Action cites Gabber.

Gabber does not provide any teaching of sorting received emails based on intended versus unintended communication partners of an email address. Gabber simply provides a separate email box for each email address but, within an email address box, there is no sorting of the messages based on intended versus unintended communication partners. In addition, Gabber provides a mechanism to sort emails based on the email address that is converted within the system from the base address. The converted email address may be utilized by a communication partner, and thus, based on the converted address, the system can sort the received messages. However, as multiple parties (intended and unintended) may use the same address, and such messages may be equally received and handled, the

system clearly does not provide a mechanism to sort between intended and unintended communication partners of a single email address. In fact, Gabber indicates at Column 3, lines 30-34, that the system would permit receipt of messages from unintended partners (junk mail) and that the system could be used to trace the origin of the address and possibly determine how the unintended party obtained access to the email address. Such a system, however, does not provide a mechanism to organize the incoming emails received based on the status of the communication partner, but rather provides a mechanism to determine after the messages have been received and sorted based on the address whether the email was authorized and, if not, to try to determine how the access was improperly granted.

Furthermore, the Office Action fails to recite a proper motivation to combine. The provided motivation is simply a conclusory statement of the effect of the combination, not of the motivation to make such a combination. The recitation in the Office Action is clearly a case of improper hindsight reconstruction using Applicant's claims as a roadmap. Similar to the motivation provided above with respect to the combination of Pennell, Winbladh, Waskiewicz, and Hall, the cited motivation in the Office Action does little more than restate a portion of the teachings of Gabber. The Office Action provides no reason why one would be motivated to combine the teachings, but rather attempts to identify the result if one made such a combination. Such a presentation is insufficient to establish a motivation to combine the references.

Therefore, Pennell, Winbladh, Waskiewicz, and Gabber fail to teach at least one element of claim 33, there is no motivation to combine, and thus claim 33 is patentable over the cited references.

Claims 35, 50, and 52 contain language similar to that discussed above with respect to claim 33. As claim 33 is patentable over Pennell, Winbladh, Waskiewicz, and Gabber, so are claims 35, 50, and 52 for at least the reasons discussed above with respect to claim 33.

Claims 34, 36-38, and 53-55 are dependent on claims 33, 35, 50, and 52 incorporating their limitations respectively. Therefore, for at least the same reasons

discussed above, claims 34, 36-38, and 53-55 are patentable over Pennell, Winbladh, Waskiewicz, and Gabber.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-6, 12-20, 24, 26-29, 31-38, 41-46, and 48-71 are in condition for allowance and early issuance of the Notice of Allowance is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 796-2844. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

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/Steven J. Prewitt/  
Steven Prewitt  
Reg. No. 45,023

Schwabe, Williamson & Wyatt, P.C.  
Pacwest Center, Stes. 1600-1900  
1211 SW Fifth Avenue  
Portland, OR 97204-3795  
Telephone 503.222.9981